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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2192

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,786

Applicant(s)

HELLERSTEIN ET AL.

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to a request for reconsideration filed April 4, 2005.
2. Claims 1-22 remain pending.

Response to Argument

3. Applicant's arguments with respect to claims 1-22 have been fully considered but they not persuasive. The following is an examiner's response to Applicants' arguments.

a. **Rejection of Claims 1-4, 8-13, 17-19, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Applicants' Admitted Prior Art ("AAPA")**

Claim 1:

First limitation of the Claim:

Applicants' arguments:

AAPA describes the manual selection of potential distribution targets by a software distribution administrator, in which the administrator prepare software to be distributed to a set of desktop machines. A configuration file is consulted to determine which target machine should receive the new software, and the software package is stored in a package repository. When there is a request for distribution of the software package, the package is downloaded to the distribution server, and distributed by the distribution server to the distribution target computer systems.

Regarding the preparation of the software package, AAPA fails to disclose that the preparation is capable of being based on policy data indicating which of the one or more regions are candidates for receiving the software package. AAPA also fails to disclose that the preparation is capable of being based on dependency information indicating requisites for a service provided by the software package. Finally, in the preparation of the software package, AAPA fails to disclose that the preparation is capable of being based on configuration information for each of the candidate regions. AAPA has no description of candidate regions in a distributed network.

Applicants further argue that:

Further, this preparation is being performed by a programmer, and thus, the method is not automated, as recited in the independent claims of the present invention.

Examiner's response:

The U.S. Court of Customs and Patent Appeals has held that claims are to be given their broadest reasonable interpretation during the prosecution of a patent application. In re Pearson 494 F.2d 1399, 1403, 181 USPQ 641, (CCPA 11974).

In this instance, Claim 1 recites three criteria upon which preparation of a software package is being based:

- (i) *policy data indicating which the one or more regions are candidates for receiving a software package;*
- (ii) *dependency information indicating requisites for a service provided by a software package; and*
- (iii) *configuration information for each of the candidate regions.*

A broad and reasonable interpretation of limitations (i) and (ii) would read on the criteria for determining which machine should receive the new software using a configuration file as described in Applicants' Background section of the disclosure. The examiner notes that limitations concerning policy data, dependency information and configuration information described in the specification should not be read into the Claim and thus any arguments that these limitations provide patentable distinction over the prior art are unpersuasive. However, these arguments would be persuasive if these limitations are specifically recited in the Claim.

In response to Applicants' argument that the method is not automated, it was known at the time of the invention that merely providing an automatic

means to replace a manual activity which accomplishes the same results is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of preparing a software package to be distributed gives you just what you would expect from the manual step as shown in AAPA. In other words, there is no enhancement found in the claimed automated step. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

Furthermore, the examiner notes that the method of performing automated distribution of a software package to a target machine is only recited in the preamble of the independent Claims but nowhere recited in the body of these Claims. Thus, the argument that the method of AAPA is not automated is considered moot.

Second and fourth limitations of the Claim:

Applicants' arguments:

Regarding the distribution of software packages, AAPA fails to disclose the distribution of the base software package to candidate regions of the distributed network, and the distribution of customized software packages to target machines in the candidate regions. AAPA includes only one distribution step, from a server to targets, in step 6 of FIG. 1. Further, AAPA does not distinguish between a base software package and a customized software package.

Examiner's response:

Claim 1 recites:

(ii) *distributing the base software package to each of the candidate regions of the distributed network;*

(iv) *distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the distributed network.*

AAPA indicates that in step 5 of a typical conventional software distribution system, the software package prepared by an administrator is downloaded to the distribution server and in step 6, the software package is distributed by the distribution server to the distribution target computer systems.

A broad and reasonable interpretation of the claimed “candidate region” of a distributed network and of the claimed “target machine” of a candidate region would read respectively on a “distribution server” and on a “target computer system” described in Applicants’ Background section of the disclosure. Thus, absent any specific techniques of distributing software package which are patentably distinct from those of the prior art, the claimed distributing step is not considered a novelty in the art and is based on the same principle of distributing software in a typical conventional network, whether the software package is distributed to a candidate region or to the target machines inside a candidate region.

Therefore, limitations (ii) and (iv) are considered anticipated by AAPA.

Third limitation of the Claim:

Applicants’ arguments:

Regarding the customizing of the software package at each of the candidate regions, AAPA fails to disclose any customization steps. In addition, AAPA fails to disclose that the software package customization is capable of being based on regional distribution policies. AAPA also fails to disclose that the customization is capable of being based on dependency information specific to one or more roles performed by the target machines in that region. Finally, in the customization of the software package, AAPA fails to disclose that the

preparation is capable of being based on individual target machine configuration information.

Examiner's response:

In response to Applicants' arguments, the examiner notes that when he interprets the claimed third limitation to read on step 6 of AAPA's FIG. 1, he considers the third limitation in the context of Claim 1 taken as a whole as he does step 6 in the context of a typical conventional software distribution system illustrated in FIG. 1. Thus, before the software package is distributed by the distribution server to the distribution target computer system in step 6, the customizing step of the software package (as claimed in the third limitation of Claim 1) has been completed in step 2 so that the software package can be specifically configured to work correctly with the target machine.

Claims 2-4, 8, 9, 11-13, 17-19:

See the rejection of these Claims in the section of the Office action where the rationale for the rejection of these Claims is discussed.

b. Rejection of Claims 5, 14 and 20 under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Gendron

In response to Applicants' arguments that these Claims recite patentable subject matter in their own right and that the combination Of AAPA and Gendron fails to disclose the preparation, customization and distribution limitations recited in the independent Claims, the examiner respectfully draws Applicants' attention to section of this Office action where the rationale for the rejection of these Claims is discussed.

According to the foregoing discussion, the rejections of Claims 1-22 are

maintained.

Claim Rejections – 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 8-9, 10-13, 17-18, 21 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's Admitted Prior Art (AAPA).

The AAPA discloses at least:

preparing a base software package for each of the one or more regions based on configuration information for each of the candidate region (see at least Figure 1, step 1 and related discussion in the specification);

distributing the base software package to each of the candidate regions of the distributed network (see at least Figure 1, step 5 and related discussion in the specification);

customizing the base software package received at each of the candidate regions based on individual target machine configuration information (see at least Figure 1, step 6 and related discussion in the specification); and

distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the distributed network (see at least Figure 1, step 6 and related discussion in the specification).

Claims 2 and 11

Since the Office's interpretation of claim 1 does not give weight to the limitation (ii) because of how the claim is being written (see section 8 above), the art rejection of features of claims 2 and similar claim 11 is not considered.

However, it is noted that although AAPA does not specifically disclose *wherein the dependency information indicating requisites for a service provided by the software package comprises at least one of a pre-requisite, an ex-requisite and a co-requisite associated with installation of the software package on a target machine*, these features are deemed to be inherent in AAPA, Figure 1, steps 1, 2, 3 and item 16; and related discussion in the specification).

Claims 3 and 12

Since the Office's interpretation of claim 1 does not give weight to the limitation (ii) because of how the claim is being written (see section 8 above), the art rejection of features of claims 3 and similar claim 12 is not considered.

Furthermore, assuming *arguendo*, that these features are being given weight, it is noted that although AAPA does not specifically disclose *wherein the dependency information indicating requisites for a service provided by the software package is represented in the form of a multi-level tree*, this feature is deemed to be inherent in AAPA, Figure 1, steps 1, 2, 3 and item 16; and related discussion in the specification).

Claims 4 and 13

Since the Office's interpretation of claim 1 does not give weight to the limitation (ii) because of how the claim is being written (see section 8 above), the art rejection of features of claims 4 and similar claim 13 is not considered.

Furthermore, assuming *arguendo*, that these features are being given weight, it is noted that although AAPA does not specifically disclose *wherein one or more of leaves of the tree*

represent one or more software components, this feature is deemed to be inherent in AAPA, Figure 1, steps 1, 2, 3 and item 16; and related discussion in the specification).

Claims 8 and 17

AAPA further discloses *the step of maintaining a policy repository indicating steps needed to construct distributable component packages for different regions and different end user environments* (see at least Figure 1, step 3 and item 16; and related discussion in the specification).

Claims 9 and 18

AAPA further discloses *wherein the individual target machine configuration information used to customize the base software package received at a candidate region is one of stored prior to use and determined at the time of use* (see at least Figure 1, step 2 and related discussion in the specification).

Claim Rejections – 35 USC § 103

6. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA as applied to the base claims, in view of U.S. Patent No. 6,484,247 to Gendron et al. (“Gendron”).

Claims 5 and 14

AAPA does not specifically disclose *wherein the one or more roles performed by the target machines in a region comprise a client role, a server role and a standalone role*. However, Gendron discloses a network that can contain any combination of client and server systems and the nodes inside this network can be standalone systems (5:59 – 6:8) for the purpose of improving the installation of software installation in a network system. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine this feature with AAPA for the purpose set forth above.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu “Antony” Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 to 17:15.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANTONY NGUYEN-BA
PRIMARY EXAMINER
ANTONY NGUYEN-BA

Art Unit 2192

June 21, 2005